

In the Supreme Court

**OF THE
United States**

OCTOBER TERM, 197

Supreme Court, U. S.

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No. _____

76-1425

**MAURICE A. GARBELL, INC.,
and
GARBELL RESEARCH FOUNDATION**

Petitioners,

v.

THE BOEING COMPANY,

Respondent.

AND

**MAURICE A. GARBELL, INC.,
and
GARBELL RESEARCH FOUNDATION**

Petitioners,

v.

McDONNELL-DOUGLAS CORPORATION,

Respondent.

**PETITION FOR WRIT OF CERTIORARI
to the United States Court of Appeals
for the Ninth Circuit**

**GEORGE B. WHITE
806 Grant Building
1095 Market Street
San Francisco, Calif. 94103
Counsel for Petitioners**

March 22, 1977.

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STATUTORY PROVISIONS ON PATENTABILITY
OF INVENTIONS AND GRANT OF PATENTS.
35 U.S.C.A.

35 U.S.C. 102. Conditions for patentability;
novelty and loss of right to patent

A person shall be entitled to a patent unless

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

.

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective date of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. July 19, 1951, c. 950, par. 1, 66 Stat. 797.

35 U.S.C. 103. Conditions for patentability;
non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 19, 1952, c.950, sec. 1, 66 Stat. 798.

35 U.S.C. 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. 282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity shall rest on a party asserting it.

. . . July 19, 1952, c. 950, sec. 1, 66 Stat. 812.

35. U.S.C. 285. Attorney fees

The court in exceptional cases may award reasonable attorney fees to the prevailing party. July 19, 1952, c. 950, sec. 1, 66 Stat. 813.

**TO THE HONORABLE WARREN E. BURGER,
CHIEF JUSTICE OF THE UNITED STATES, AND TO
THE HONORABLE ASSOCIATE JUSTICES OF THE
SUPREME COURT OF THE UNITED STATES:**

Maurice A. Garbell, Inc., a corporation, and Garbell Research Foundation, a corporation, petitioners, respectfully pray that a writ of certiorari issue to review the opinion and decision of the United States Court of Appeals for the Ninth Circuit entered in the above-entitled cases on November 10, 1976; a Petition for Rehearing was denied by the Circuit Court of Appeals on December 28, 1976.

OPINIONS BELOW.

The preliminary findings and memorandum decision of the District Court are reported at 385 F.Supp. 1. A copy thereof appears in Appendix A. The opinion and decision of the Court of Appeals is reported at 546 F.2d 297, and a copy of it appears in Appendix B. The Order of the Court of Appeals, denying the Petition for Rehearing appears in Appendix C.

JURISDICTION.

The Decision of the U. S. Court of Appeals for the Ninth Circuit was entered on November 10, 1976, and the Order denying the Petition for Rehearing was entered December 28, 1976. The jurisdiction of the District Court was based on 35 U.S.C. 271, 281, and 28 U.S.C. 1338. The jurisdiction of the Court of Appeals was based on 28 U.S.C. 1282.

This Petition for a Writ of Certiorari is filed less than 90 days from the date of said Order. The jurisdiction of this Honorable Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED FOR REVIEW.

The District Court sustained all of the defenses against the validity of U.S. Patent No. 2,441,758, a patent on a novel airplane-wing shape, and ruled the cases "exceptional" for the purpose of awarding attorneys' fees in the amount of \$237,062.50 and costs in the amount of \$51,943.03 against plaintiffs. The Court of Appeals for the Ninth Circuit affirmed the district-court judgment "in all respects."

The questions presented below call for the exercise of this Honorable Court's power of supervision and review, for the reason that the rules and standards affirmed by the Court of Appeals in the instant cases are in conflict with the rules and standards uniformly applied in infringement actions by a majority of the circuits in the United States, and by this Honorable Court and the Court of Claims, involving important questions of general significance that should be resolved by this Court.

The questions presented are:

I. Whether a patent holder is to be punished by orders to pay \$237,062.50 in attorneys' fees and \$51,943.03 in costs on the flimsiest of grounds, and in total disregard of the rule requiring "clear, unequivocal and convincing evidence" of "willful acts" of misconduct.

II. Whether said punitive money judgment and the invalidation of the patent are to be made on rulings that are in conflict with the requirement for "clear and convincing evidence" to overcome the strong presumption of validity of a patent under the Statute.

I. QUESTIONS ON "CLEAR, UNEQUIVOCAL AND CONVINCING EVIDENCE" REQUIRED TO ESTABLISH A CASE AS "EXCEPTIONAL."

I-1. Whether a holding of "bad faith" by the inventor and patentee, and a holding that the conduct of the inventor and patentee "was below the standards of good faith and candor required by inventors dealing with the Patent Office," satisfies the standard uniformly applied in infringement actions by the majority of circuits in the

absence of a finding by the District Court of any "willful act" on the part of the inventor and patentee on which such findings and conclusions of law of "bad faith" or "lack of candor" could be predicated.

I-2. Whether a lawsuit is "brought improvidently," when it is brought on the advice of attorneys on a patent that had been held valid and infringed in a previous suit in another District Court in the same District, and after the plaintiffs have proved infringement in the instant action.

I-3. Whether a holding of "intransigence and vexatious behavior by the plaintiffs which ran up costs" which holding relies on "circumstantial evidence" that is not specified, satisfies the standard uniformly applied in infringement actions by the majority of circuits, that misconduct under either theory must be established by "clear, unequivocal and convincing" evidence if a case is to be held to be "exceptional" for the purpose of awarding attorneys' fees, as is summarized, for example, in Pfizer, Inc. v. International Rectifier Corp., 538 F.2d 180 (8th Cir. 1976). (35 U.S.C. 285).

II. QUESTIONS ON THE "CLEAR AND CONVINCING PROOF" TEST REQUIRED TO OVERCOME THE STRONG PRESUMPTION OF THE VALIDITY OF A PATENT UNDER 35 U.S.C. 282.

Whether summary affirmation by the Court of Appeals for the Ninth Circuit of the Findings of Fact and Conclusions of Law of the District Court "in all respects," sustaining all defenses against the validity of the patent, is not in conflict with the general and fundamental rule that, in order to overcome the strong presumption of validity of a patent, the "clear-and-convincing-proof" test must be applied to each defense as required by decisions of this Honorable Court and the Courts of Appeals of other circuits. (35 U.S.C. 282).

In the instant cases, this basic question arises as to each of at least the following defenses:

II-1. Whether the delivery of a single 3/40th-scale miniature static wind-tunnel model, sold exclusively for experimental wind-tunnel testing, constitutes a "clear and convincing proof" of "on sale" of an airplane and its wing under the rules exemplified in Ushakoff v. United States (Ct.Cl.1964) 327 F.2d 669, at 677. (35 U.S.C. 102(a)).

II-2. Whether, after the adoption by the District Court of the Findings of the Special Master, in which the Special Master made a Finding as to the one and only anticipation of the patent in suit by the so-called "Curtiss-Wright Development," namely, that:

"It is true that the evidence is less than one would desire to determine definitively and free from doubt what shape the CW-23 airfoil probably took." (Emphasis added),

the correct conclusion of law could be anything other than that the defendants' proof failed to satisfy the "clear-and-convincing-proof" test required for an invalidating anticipation. (35 U.S.C. 102(g)).

II-3. Whether the evaluation, under oath, by the designer of the Defendants Douglas' accused DC-8 wing as "revolutionary," which DC-8 wing was found by the Special Master to have the same airfoil shape as the wing of the patent claims in suit, thereby accomplishing "revolutionary" operational and safety advantages, should be a factor in the proof of unobviousness. United States v. Adams, 383 U.S. 39, 86 S.Ct. 708, 713, 15 L.Ed. 572 (1966). (35 U.S.C. 103).

II-4. Whether the Findings of "inoperativeness" and "indefiniteness" satisfy the "clear-and-convincing-proof" requirement under 35 U.S.C. 282 in the face of a prior decision of another District Court (94 F.Supp. 843), reversed on the ground of shopright (204 F.2d 946), that the patent was valid and that hundreds of commercially operating Consolidated-Vultee "Convair-240" airliners constituted infringement of the patent in suit, and in the

face of the Special Master's Finding, adopted by the present District Court here, that Defendant Douglas' accused DC-8 airliners have the same airfoil shape as that of the patent in suit, and where the record contains prima-facie proof of infringement by successfully "operating" DC-8 airliners. Freedman v. Overseas Scientific Corp., (C.A. N.Y. 1957) 248 F.2d 274, at (276. (35 U.S.C. 112)).

II-5. Whether the submittal of a sole original manuscript to the Editorial Board of a professional society journal for consideration of possible later publication therein should constitute "printed publication" contrary to all existing rules of law. Application of Tenney, 254 F.2d 619, at 621. (35 U.S.C. 102(a)).

II-6. Whether the rule requiring "clear and convincing proof" is satisfied by the prior publications and knowledge which "contained no other wing description (that) exactly duplicates the Garbell wing", and whether, in addition, the presumption of validity is further strengthened by the admission of Defendants' expert Abbott that the Cronstedt patent, which was considered and cited by the Patent Examiner in the patent in suit, was closer than any of said prior publication and knowledge. Universal Athletic Sales Co. v. American Gym, etc., supra (35 U.S.C. 282).

II-7. Whether it was incumbent on the Court of Appeals, in the light of the "clear-and-convincing-proof" requirement of the United States Code, to examine the record and ascertain that there is absolutely no evidence of any kind in the record that would support the defenses of an exchange of classified data, a distribution of any report by Consolidated-Vultee, any "offer of sale" to a Captain Diehl of the U.S. Navy, any "sale" to the U.S. Air Force, or any unclassified disclosure to anyone that could invalidate the patent in suit.

STATEMENT OF THE CASE.

This is a suit for infringement of United States Patent No. 2,441,758, granted to Maurice A. Garbell, which patent was assigned to Plaintiffs. The patent is entitled "Fluid Foil Lifting Surface" (Appendix D); the patent covers a novel airplane-wing shape that achieves a novel and safe wing-stall ("loss-of-lift") characteristic in conditions of high wing lift. Prior wings had stalled at the tip or at the root; they had pitched up and rolled over into an ultimate crash when a high angle of attack had been exceeded inadvertently. The wing of the Garbell patent generates a broad inboard-panel stall and restores its lifting capability by a gentle, safe, pitch-down, free from excessive roll. Throughout the trial, the invention was frequently referred to as the "Garbell Wing," which term shall be used in this Petition for Writ of Certiorari.

The patent was issued on May 18, 1948, on an application filed on July 16, 1946. The Plaintiffs filed an infringement suit, in 1948, against Consolidated-Vultee Aircraft Corporation (later succeeded by General Dynamics Corporation) in another District Court in the same District. In that action (94 F.Supp. 843, S.D. Cal. 1950) the patent was held valid and infringed, but, on appeal from that judgment, the Court of Appeals for the Ninth Circuit held that Consolidated-Vultee had a shopright under the patent (204 F.2d 948, 9th Cir. 1953).

The first Complaint in the present Boeing and McDonnell-Douglas cases, which cases were subsequently consolidated, was filed on June 6, 1963. The patent expired during these litigations on May 18, 1965.

After some discovery proceedings, the trial court granted Defendants' motion, over Plaintiffs' objections, that the case be referred to a Special Master. One of the grounds of Plaintiffs' opposition was that the limited funds of the Plaintiffs could not provide for the inevitable very heavy expenses of such reference.

Numerous depositions were taken, and Defendants had the Special Master accompany Defendants' counsel to the East Coast and other distant locations, at Defendants' expense, to be in attendance at several of the depositions.

Thereafter, in 1970, evidentiary hearings on the geometric shape of various airfoils and wings were held before the Special Master for a period of 30 hearing days (seven elapsed weeks). Thereupon the Special Master issued Findings which in almost all respects were favorable to the validity of the patent. The only material issue on which the Special Master made a finding unfavorable to Plaintiffs was on alleged prior art by a "Curtiss-Wright Development" related to the Curtiss-Wright Model 23 and 21-B airplanes. As to the shape which the Special Master believed the critical "CW-23 airfoil probably took," the Special Master conceded that:

"It is true that the evidence is less than one would desire to determine definitively and free from doubt what shape the CW-23 airfoil probably took."

The Special Master found that none of the prior publications presented to him for Findings suggested a Garbell wing.

The Special Master made a finding as to the shape of the DC-8 wing of Defendant McDonnell-Douglas, and that shape is the same as that of the Garbell wing of the patent in suit.

After the hearing before the Special Master, the trial judge adopted the Findings of the Special Master. The case was set for trial. The court ordered the trial to be limited to the issue of the validity of the patent in suit, and the trial was held accordingly.

The trial judge rendered judgment, holding the patent invalid on all the defenses pleaded, and awarded to Defendants attorneys' fees in the amount of \$237,062.50 and costs in the amount of \$51,943.03.

Defenses and Findings.

At the time of final argument the District Judge announced, in substance, that he did not find that the acts of Dr. Garbell before the Patent Office were wrongful or willful or that there was any fraud on the Patent Office.

Among the defenses on which the District Court made findings were the following:

1. A few non-consecutive pages from an unpublished aerodynamic proposal report of the Curtiss-Wright Corporation, obtained by the Defendants from the printed transcript on appeal of the previous infringement suit (94 F.Supp. 843, S.D. Cal. 1950), in which the patent was held valid, but which was reversed on the ground of shopright. There was no explanation, in either trial, why about 120 pages were missing. (204 F.2d 946. 9th Cir. 1953).

2. Copies of documents, such as: "Zien Thesis, Technical University of Berlin," "Lachmann article in the Journal of the Royal Aeronautical Society," "Lombard article in the Journal of the Aeronautical Sciences," "N.A.C.A. Technical Report No. 703," "Article written by Dr. Garbell on the 'Pinguino' sailplane in the Italian periodicals 'Le Vie dell'Aria' and 'L'Aquilone'," all of which are also contained in the said printed transcript of record on appeal in the previous infringement case.

3. The Cronstedt patent, which is cited in the Patent-Office "file wrapper" and on the face of the patent in suit, and which, hence, was considered by the Examiner in the Patent Office.

4. The contract for a 3/40th-scale non-flyable miniature experimental wind-tunnel model of an XB-46 airplane design with a Garbell wing shape, sold solely for experimental wind-tunnel testing.

5. A suggestion for an exchange of classified data between aircraft manufacturers which was never carried out.

6. An alleged offer of sale by Dr. Garbell to a Captain Diehl of the Bureau of Aeronautics of the U. S. Navy and/or others. This refers to a discussion between Dr. Garbell and Captain Diehl regarding a possible interest by the U. S. Navy in a tailless airplane configuration.

7. Prior knowledge and publication attributed to a classified intramural report of NACA wind-tunnel tests of a classified Consolidated-Vultee design-model wing following a confidential discussion between Dr. Garbell and an employee of the NACA who was in charge of the Consolidated-Vultee wind-tunnel test.

8. Alleged printed publication more than a year prior to the filing date of the application for the patent in suit by submittal of a single manuscript to the Editorial Board of the Journal of the Aeronautical Sciences, for consideration of possible subsequent publication in the Journal (not published until much later, well within the statutory year).

9. Inoperativeness and Indefiniteness.

10. Obviousness.

11. Fraud in the Patent Office and/or bad faith in the litigation.

12. Estoppel against the present Defendants by reason of their involvement in the previous litigation, Maurice A. Garbell, Inc. et al. v. Consolidated-Vultee Aircraft Corporation, etc., supra, through the activities of the Manufacturers Aircraft Association, of which the present and the past defendants were and are co-owners and members.

All of the defenses were sustained by the District Court, even though, on "fraud," the District Court held, "no fraud," but some unspecified and unsubstantiated "lack of candor, less than good faith, etc."

The Court of Appeals summarily sustained the District Court's Findings of Fact and Conclusions of Law "in all respects," and sustained the District Court's finding of "bad faith" and award of attorneys' fees in the amount of \$237,062.50 and costs in the amount of \$51,943.03.

REASONS FOR GRANTING
THE WRIT OF CERTIORARI.

To hold a case "exceptional" because of alleged misconduct before the Patent Office or in the litigation, there must be "clear, unequivocal and convincing" evidence of a "willful act * * * which rightfully can be said to transgress equitable standards of conduct."

United States v. American Bell Telephone Co., (1897)
167 U.S. 224, 251;

Pfizer, Inc. v. International Rectifier Corp.
(8th Cir. 1976) 538 F.2d 180, 186-187;

Schnadig Corp. v. Gaines Mfg. Co. (6th Cir. 1974)
494 F.2d 383, 391; and

Monsanto Co. v. Rohm & Haas Co. (3d Cir. 1972)
456 F.2d 592, 601, fn. 14, certiorari denied (1972)
407 U.S. 934.

Section 282 of Title 35 of the United States Code provides:

"A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

In order to have a patent held invalid, there must be "clear and convincing" proof to overcome the strong presumption of validity of the Statute. Cantrell v. Wallick, 17 U.S. 689, 29 L.Ed. 1917, and subsequent decisions by this Honorable Court requiring "clear and convincing" proof.

The decisions of the court below evade these requirements in both respects and punish the patent holders for seeking to uphold their patent rights. The question is an important one. It involves not only a basic disregard of a congressional mandate, but an in terrorem effect on small inventors who dare to assert their patents against large manufacturers.

The patent was sued upon in 1948, and its validity was sustained over the defenses of alleged prior art of the Curtiss-Wright 23 and 21-B airplanes and over alleged prior publications and alleged prior knowledge (Maurice A. Garbell, Inc. v. Consolidated-Vultee Aircraft Corporation, supra.) On appeal, it was held that Consolidated-Vultee ("CVAC") had a shopright, but that did not tell the patent holders that they did not possess a valid patent.

The patent holders were advised by their attorneys, who were experienced in aviation matters, to file a suit for infringement against these Defendants. There was no other way to establish the actual shape of the wings manufactured by Defendants, except by court-ordered discovery proceedings. Even that discovery was strenuously opposed by Defendants for nearly ten years, thereby causing colossal expenses to plaintiffs. The plaintiffs proved infringement by the wings of the Douglas DC-8 airplanes. Hence, it is unconscionable to say that the suits were brought "improvidently."

Under the rule of the requirement for "clear, unequivocal and convincing evidence," the holding by the Court of Appeals of "circumstantial evidence of intransigence and vexatious behavior by the plaintiffs which ran up costs," in the absence of any findings by the District Court of any specific willful act by plaintiffs, is also in conflict with Pfizer, Inc., v. International Rectifier Corp., supra, especially since the only sanction ordered by the Special Master, during pretrial discovery, was against Defendant Boeing, wherein the Special Master stated:

"Defendant's delay in disgorging the information has in all events been unreasonable and I have no doubt that it has been deliberate." (Emphasis added.)

Nothing occurred between 1950 and 1953 to disabuse the patent holders of their understanding that their patent was and is valid. In 1963, Plaintiffs sued The Boeing Company and the Douglas Aircraft Company for

infringement of the patent. In 1972, the trial court held the patent in suit invalid because of alleged prior art and prior publication and knowledge.

As to the prior art, the Curtiss-Wright wings had been held twenty years before to be non-anticipatory. In the current actions, the Special Master, in his Findings after a seven-week-long hearing, held that "the evidence is less than one would desire to determine definitively and free from doubt what shape the CW-23 airfoil probably took."

As to the prior publications and prior knowledge, all except the Zacher article had been held twenty years before not to be anticipatory, and the District Court, at that time, held that the Garbell wing was non-obvious over them. The Zacher paper was not in the previous suit in 1950, but is a "manuscript" prepared for the aeronautical storm-troop cadres of the Nazi party, allegedly in 1944, by a Dr. Zacher.

On the question of the alleged prior publications, the Court of Appeals held:

"Although no other wing description exactly duplicated the Garbell wing, the (district) court found that a consideration of the totality of the prior publications would render the design obvious to a skilled member of the airframe industry." (546 F.2d 297, 299. Emphasis added).

All of the alleged prior publications, except the Zien, Lachmann, and Zacher papers, had been considered and found wanting by the Patent Office, and all except Zacher were found wanting again in 1950 in the Consolidated-Vultee trial in the same District in which the instant Boeing and McDonnell-Douglas suits were tried. The Zacher article was not produced by the defendant in the 1950 case; it was first produced in the instant cases by the Boeing and Douglas Defendants. The Zacher paper is in the German language. No English-language translation was ever offered. The Zacher paper

was never published. It does not describe a Garbell wing shape, and the Special Master characterized it as meaningless in his findings which were adopted by the District Court.

Petitioners respectfully submit that to find this patent invalid and the patent holders in bad faith on such flimsy "evidence" clearly demonstrates an utter disregard by the lower courts for the presumption of patent validity and the requirement for clear and convincing evidence to overcome the strong presumption of patent validity.

The findings of the district court cannot be accepted as a fair or truthful characterization of the facts or the evidence. Essentially, the findings were copied from those drafted and proposed by Defendants in violation of the law laid down by this Honorable Court. United States v. El Paso Natural Gas Co. 376 U.S. 651, 656-657. S.Ct. 1044. 12 L.Ed.2d 12. Kelson v. United States (10th Cir. 1974) 503 F.2d. 1291, 1294-1295. One would not know from the opinion of the District Court, for example, that the Special Master had ordered only one sanction in pretrial discovery, and that one sanction was against the Defendants, in the language recited supra.

The decision itself is replete with errors, contradictions, and inconsistencies, obfuscated by prolixity. To cite but a few examples that will illustrate the utter confusion of the findings:

a. The District Court found that the article published on the "Pinguino" sailplane built and flown by Dr. Garbell in Italy is a form of anticipation (Finding H10); that the "wing of the Pinguino sailplane is not covered by any of the claims of the patent in suit" (Finding H12); and that the patentee (the designer and builder of the Pinguino sailplane) did not reduce to practice his invention at any time.

b. The District Court found that the Garbell invention had never been reduced to practice; yet the District Court found that the sale of a non-flyable miniature experimental wind-tunnel model of an airplane design

with a Garbell wing shape, sold solely for experimental wind-tunnel testing, constitutes an airplane or an airplane wing being "on sale" more than one year prior to the filing date of the application for the patent in suit, so as to invalidate the patent. This latter new rule is already being cited as "confusing law," as is indicated in the photocopy, reproduced here on the next page, of page 623 of the October 1974 issue of the Journal of the Patent Office Society. Sooner or later some of the other defenses so affirmed, contrary to well-established law, are bound to be similarly cited as precedent.

c. The findings of the Special Master and the District Court on the "Curtiss-Wright Development" would provide a precedent for holding a patent invalid on "evidence less than one desires to determine definitively and free from doubt." This is a radical departure from the rule of law in Cantrell v. Wallick, *supra*, and subsequent decisions by this Honorable Court requiring "clear and convincing" proof to overcome the strong presumption of patent validity under the Statute, 35 U.S.C. 282.

d. The holding of obviousness by the District Court, as affirmed "in all respects" by the Court of Appeals, would be held as a precedent for the proposition that theoretical papers and doctoral theses which were advocating on paper wing shapes creating so-called "root-stall" characteristics, without proof of operativeness in an actual airplane, could negative novelty of a concededly different and novel wing shape which creates the novel broad-inboard-panel wing-stall characteristic of the Garbell wing.

The latter newly established precedent, disregarding novel result, is in conflict with the rule stated by this Honorable Court in United States v. Adams, *supra*, at p. 714, namely,

"An inoperative invention or one which fails to achieve its intended result does not negative novelty. Smith v. Snow. 294 U.S. 1, 17, 55 S.Ct. 279, 79 L.Ed. 721 (1935)."

vention has been held to be a sufficient reduction to practice where the inventor presented his ideas fully on paper to an architect who was satisfied that the invention would accomplish its intended purpose, and one skilled in the art could readily have built and used the invention (a frame).³⁴ And sale of a wind tunnel model of an airplane wing was held to be a bar to the patent for the wing.³⁵

Thus, there appears to be either some confusion or a split of opinion as to whether an invention is complete, or perfected, for sale purposes when it has been reduced to practice (i.e., operative to accomplish the desired result in a practical way) or whether it must have a commercially acceptable structure and operation. This seems to imply a difference in the interpretation of what the term "in a practical way" signifies. The author believes that it is more logical for on sale purposes that, if the invention is to be used commercially, it should have a commercially acceptable structure and operation. However, this does not imply that there must be a working model, but only that the form of the invention, even if it is only on paper, be acceptable to prospective purchasers who desire to use the invention in its intended environment. E.g., if it is a machine which manufactures paper cups, a paper-cup manufacturer would buy it to use to manufacture paper cups which he can sell commercially.

An experimental use may be by one other than the inventor if the inventor maintains control over the use.³⁶

This is also true where the invention is sold; if the purpose of the sale is primarily experimental and the profit is only incidental, the use will be held to be experimental.³⁷ However, there is a case³⁸ in which the court

³⁴ Langzett v. Marmet, D.C., W. Wisc., 141 USPQ 903.

³⁵ Garbill v. Boeing, D.C. S. Cal., BNA Patent, Trademark & Copyright Journal #150, pg. A-1.

³⁶ Electric Storage Battery v. Shimadzu, 59 S. Ct. 675, 307 U.S. 5, 613; cert. den. 62 S. Ct. 916, 315 U.S. 822.

³⁷ Sterling Products v. Crest Manufacturing, D.C., Mich. 166 USPQ 129.

³⁸ Cali v. Eastern Air Lines, CA 2, 169 USPQ 753.

A fortiori the rule of the Adams case applies where the shape of the accused DC-8 airplane wing embodying the Garbell wing shape was characterized by defendant Douglas' wing designer as "revolutionary."

e. The District Court's findings on inoperativeness and indefiniteness, as affirmed "in all respects" by the Court of Appeals, are also bound to be cited as precedent that hundreds of successfully operating airliners, which were held in the prior patent-infringement case against Consolidated-Vultee to be infringements (Maurice A. Garbell, Inc., et al. v. Consolidated-Vultee Aircraft Corporation, supra) and the findings of the Special Master that defendants' DC-8 airplane wings have the shape of the Garbell wing patent, are not sufficient to prove that the Garbell invention is operative. Freedman v. Overseas Scientific Corp., supra. (35 U.S.C. 112).

f. The District Court's finding, which, together with its affirmation by the Court of Appeals "in all respects," eventually will be cited as precedent that the submittal of a single draft manuscript to the Editorial Board of a professional society more than one year prior to the filing date of a patent application is a "printed publication," gives a new, and unexpected, interpretation of the statutory provision regarding a "printed publication." Application of Tenney, supra. (35 U.S.C. 102(a)).

In assessing over a quarter of a million dollars against the patent holders in attorneys' fees and costs, the court brutally penalized petitioners in clear violation of the rules of law concerning proof of alleged misconduct before the Patent Office or in the litigation.

As stated in Pfizer, Inc. v. International Rectifier Corp., 538 F.2d 180, 186 (8th Cir. 1976):

".... we note that the standard is not one of strict liability for innocent or even negligent omissions or misstatements before the Patent Office. Schnadig Corp. v. Gaines Manufacturing Co., 494 F.2d 383, 393 (6th Cir. 1974). Rather, to result in refusal to enforce

a patent, the misconduct must be accompanied by "some element of wrongfulness, willfulness, or bad faith." Parker v. Motorola, Inc., 524 F.2d 518, 535 (5th Cir. 1975); see Precision Instrument Manufacturing Co. v. Automotive Maintenance Machinery Co. 324 U.S. 806, 814-815, 65 S.Ct. 993, 997-998, 89 L.Ed.1381 (1945) (a "willful act * * * which rightfully can be said to transgress equitable standards of conduct"). This requirement of proof has been uniformly applied in infringement actions by a majority of the circuits to claims of both fraud¹³ and lesser inequitable conduct.¹⁴ Moreover, proof of misconduct under either theory must be established by 'clear, unequivocal and convincing' evidence. United States v. American Bell Telephone Co., 167 U.S. 224, 251, 17 S.Ct. 809, 42 L.Ed. 144 (1897); accord, Schnadig Corp. v. Gaines Manufacturing Co., supra, at 392; Monsanto Co. v. Rohm & Haas, supra, at 601 n.14."

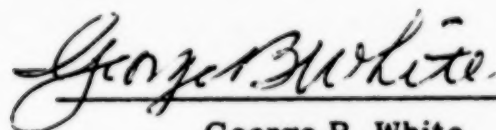
: In the cases at bar the rulings of the District Court and the Court of Appeals are in conflict with this rule.

CONCLUSION.

Petitioners respectfully submit that the Court of Appeals in these actions, as herein demonstrated, departed so far from the accepted and usual course of judicial proceedings, and so far sanctioned such a departure by the District Court herein, as to call for the exercise of this Honorable Court's power of supervision to remedy the nationally confusing and damaging inconsistencies between the Court of Appeals for the Ninth Circuit and courts of appeals in other circuits, as well as this Honorable Supreme Court and the Court of Claims.

Petitioners further respectfully urge that this Honorable Court protect the fundamental rights of petitioners in the interest of justice and agree to review the actions of the lower courts on writ of certiorari.

Respectfully submitted,



George B. White
806 Grant Building
1095 Market Street
San Francisco, CA 94103
(415) 621-7065

Attorney for Petitioners

March 22, 1977.

PROOF OF SERVICE.

I, George B. White, attorney for Maurice A. Garbell, Inc., and the Garbell Research Foundation, Petitioners herein, and a member of the Bar of the Supreme Court of the United States, hereby certify that, on the 24th day of March, 1977, I served copies of the foregoing Petition for a Writ of Certiorari to the Supreme Court of the United States on the several parties thereto, as follows:

1. On The Boeing Company, Defendant, by mailing three copies in a duly addressed envelope, with first-class postage prepaid, to its attorneys,

PERKINS, COIE, STONE, OLSEN & WILLIAMS,
J. PAUL COIE,
1900 Washington Building,
Seattle, Washington 98101.
(206) 682-8770

2. On the McDonnell-Douglas Corporation, Defendant, by mailing three copies in a duly addressed envelope, with first-class postage prepaid, to its attorneys,

LOUIS LIEBER, JR.,
WALTER J. JASON,
3000 Ocean Park Boulevard,
Santa Monica, California 90405.
(213) 399-9311, Extensions 4275.

3. On The Boeing Company and the McDonnell-Douglas Corporation, Defendants, by mailing three copies in a duly addressed envelope, with first-class postage prepaid, to their attorneys,

HAHN, CAZIER, THORNTON, HOEGH & LEFF,
RICHARD B. HOEGH,
RUSSELL P. KUHN,
Crocker Citizens Plaza,
611 West Sixth Street, Fourteenth Floor,
Los Angeles, California 90017.
(213) 628-6151.

It is further certified that all parties required to be served have been served.

George B. White

George B. White,
Attorney for Petitioners,
806 Grant Building,
1095 Market Street,
San Francisco, California 94103.
(415) 621-7065.